

REMARKS/ARGUMENTS

Claims 124-235 are pending in the application. Claims 124, 125, 127-133, 140-142, 144, 145, 152, 160, 163-165, 169-171, 173-179, 186-188, 190, 191, 198, 206, 209-211, 215-223, 226, 227, and 230-235 are amended, and claims 223-225, 230, and 233 are cancelled herein. The Applicant hereby requests further examination and reconsideration of the application in view of the foregoing amendments and these remarks.

On page 2 of the Action, the Examiner rejected claims 124-139, 141, 142, 144, 145, 147-151, 153, 155, 160-164, 166, 217, 220, 224, 225, and 230-232 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent App. Pub. No. 2002/0181009 ("Fredlund"). On page 8 of the Action, the Examiner rejected claims 140, 141, 145, 153-155, 218, 219, 212, and 227-229 under 35 U.S.C. § 103(a) as obvious over Fredlund. On page 11 of the Action, the Examiner rejected claims 152, 156, 164, 165, 169, 226, and 234 under 35 U.S.C. § 103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2005/0022119 ("Kraemer"). On page 13 of the Action, the Examiner rejected claims 146 and 222 under 35 U.S.C. § 103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2002/0143664 ("Webb"). On page 14 of the Action, the Examiner rejected claims 143 and 167 under 35 U.S.C. § 103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2003/0088497 ("Belgrano"). On page 15 of the Action, the Examiner rejected claims 168 and 233 under 35 U.S.C. § 103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2002/0178078 ("O'Toole"). On page 16 of the Action, the Examiner rejected claims 157-159 under 35 U.S.C. § 103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2004/0219936 ("Kontainen"). On page 18 of the Action, the Examiner rejected claims 148-150 under 35 U.S.C. § 103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2002/0059111 ("Ding").

For the following reasons, the Applicant submits that all of the presently-pending claims are allowable over the cited references.

On 8/20/07, the Examiner, Mila Airapetian, and her supervisor, Mark Fadok, participated in an on-site interview at the USPTO with the Applicant's attorney Kevin Drucker. The Applicant thanks the Examiner and her supervisor for the courtesy of that interview.

Claims 163, 209, and 235

As the Applicant's attorney discussed with the Examiner during the 8/20/07 interview, claims 163, 209, and 235 were not rejected based on any prior art references in the Action. The Applicant has not been provided with an opportunity to address the rejections of these claims substantively and therefore respectfully requests that the Examiner provide a basis for rejecting these claims in a subsequent action, should the Examiner find that the application is not in condition for allowance following the entry of this Amendment. Additionally, should the Examiner reject any of claims 163, 209, and 235 based on any prior art references in a subsequent office action, the Applicant respectfully notes that such office action must be a non-final action, pursuant to MPEP §706.07, since none of claims 163, 209, and 235 were rejected in the 6/5/07 Action based on any prior art references.

Claims 124-216

As the Applicant's attorney discussed with the Examiner during the 8/20/07 interview, claim 124, as amended, requires that the product being purchased be "capable of being provided

to the recipient in person at any venue in the set of one or more venues without the purchaser or the recipient providing any input other than the instruction from the purchaser, and without the purchaser or the recipient providing any content used in creating the at least one selected product." In Fredlund, either the purchaser or the recipient must upload an image file as content to create the image-bearing product. Without this image file uploaded by either the purchaser or the recipient, the image-bearing product is not capable of being provided to the recipient. Accordingly, Fredlund fails to teach, disclose, or even suggest this feature of claim 124, because in Fredlund either the purchaser or the recipient must provide as input a portion of what is being purchased, namely, content in the form of an image file to be printed on a print medium.

The Applicant's attorney and the Examiner also discussed during the 8/20/07 interview that claim 124 further requires that the product being purchased be "available for purchase in person at any venue in the set of one or more venues prior to the performance of steps (b) and (c), without the purchaser or the recipient providing any content used in creating the at least one selected product." In Fredlund, the image-bearing product is not available for purchase at the time step (b) is performed. Nor is the image-bearing product available for purchase at the time step (c) is performed. This is because, at the time steps (b) and (c) are performed, an image file has not yet been supplied by either the purchaser or the recipient, and therefore, the product being purchased does not yet exist. At best, Fredlund presents the purchaser a selection of generic features or processing options for distributing a photograph (e.g., at the time the recipient visits the kiosk, print the photograph on 8x10 paper, print the photograph on a t-shirt, etc.), but this is not the same as a list of products that are available for purchase, because these items do not actually exist until someone supplies an image file. Moreover, claim 124 requires that the product being purchased be available for purchase without the purchaser or the recipient providing any content used in creating the at least one selected product. Accordingly, Fredlund fails to teach, disclose, or even suggest these features of claim 124, because the custom image-bearing product is not available for purchase until after steps (b) and (c) are performed and an image file is uploaded by either the purchaser or the recipient, and the purchaser or recipient must provide content used in creating the custom image-bearing product.

In light of the above-described differences between Fredlund and the language recited in claim 124, the Examiner indicated during the 8/20/07 interview that claim 124 appeared to be allowable over Fredlund, if the Applicant (i) removed the phrase "or service" following the word "product" in this claim and (ii) clarified that no user-supplied content is used to create the product. Accordingly, the Applicant has amended claim 124 (and other claims similarly) as recommended by the Examiner, and it is believed that claim 124 is now in condition for allowance.

As discussed with the Examiner during the 8/20/07 interview, since Fredlund fails to teach, disclose, or even suggest the foregoing features recited in claim 124, it cannot be said that Fredlund anticipates claim 124. For similar reasons, claims 170 and 216 are also novel over Fredlund. Since claims 125-169 and 171-215 depend variously from claims 124 and 170, it is further submitted that those claims are also novel over Fredlund.

Claims 131, 177, and 217

Claim 131 recites, *inter alia*, that "step (c) further comprises providing the data enabling the authentication of the recipient to all of the venues of the set of one or more venues in advance of presentation by the recipient of (i) an identifier, (ii) a physical medium having an identifier

printed thereon, or (iii) a physical device enabling authentication of the recipient to receive the at least one selected product.”

As discussed with the Examiner during the 8/20/07 interview, the cited paragraphs of Fredlund ([0030] and [0043]) fail to teach, disclose, or even suggest a step of transmitting authentication data to ALL of the venues in the set of one or more venues PRIOR TO the recipient presenting an identifier or device to authenticate the recipient’s receipt of a product. In other words, according to claim 217, once the instruction from the purchaser is received, the authentication data is sent to all of the potential venues at which the recipient could receive the product – not just the single location at which the recipient chooses to receive the product, as taught in Fredlund. Additionally, the authentication data is sent before redemption by the recipient, in contrast to Fredlund, which authenticates the recipient’s receipt of a product at the time of redemption, and this authentication data is sent only to the specific kiosk at which the recipient is located – not to ALL of the kiosks. Since Fredlund fails to disclose transmitting the data enabling the authentication of the recipient to all of the venues of the set of one or more venues in advance of presentation by the recipient of (i) an identifier, (ii) a physical medium having an identifier printed thereon, or (iii) a physical device enabling authentication of the recipient to receive the at least one specified product, claim 131 is novel over Fredlund. For similar reasons, claims 177 and 217 are also novel over Fredlund.

Claims 140-141, 186-187, and 218-219

As discussed with the Examiner during the 8/20/07 interview, in the scenario of claim 140, a purchaser buys a product for a recipient, and then the recipient, in turn, buys a product for the purchaser. As recited in claim 140, when the recipient sends an instruction to buy the product for the purchaser, “at least a portion of the instruction from the recipient is pre-supplied without input from the recipient.” In other words, the recipient does not need to input a portion of the instruction from the recipient, such as the product being purchased or the venue(s) at which redemption occurs. This is because the original purchaser has indicated, e.g., his/her favorite drink and/or venue preference as part of his/her “instant reciprocity” settings (see the Applicant’s specification at p. 25, lines 21-22), and these stored settings are used to pre-populate the fields of the instruction from the recipient. An exemplary embodiment of this process is fully described in the Applicant’s specification, e.g., at p. 25, line 15, to p. 28, line 14. Fredlund does not teach, disclose, or even suggest a transaction in which the purchaser and recipient switch roles, whereby the recipient can initiate the “reciprocal” purchase instruction without having to input a portion of the instruction because that portion of the instruction is pre-supplied. Therefore, claim 140 is non-obvious over Fredlund. For similar reasons, claims 186 and 218 are also non-obvious over Fredlund. Since claims 141, 187, and 219 depend from claims 140, 186, and 218, respectively, it is further submitted that those claims are also allowable over Fredlund.

Moreover, as discussed with the Examiner during the 8/20/07 interview, claim 141 recites, *inter alia*, that the pre-supplied portion of the instruction “comprises at least one of (i) a purchaser name, (ii) a purchaser email address, (iii) a purchaser text messaging address, (iv) one or more venues, (v) one or more products, and (vi) payment information.” In rejecting claim 141 as anticipated by Fredlund on page 9 of the Action, the Examiner cites to item 44 of Fig. 9(a) of Fredlund. Item 44 is a purchaser’s name and address, as printed on a postcard generated by Fredlund’s system to notify a recipient of his/her opportunity to claim an image-bearing product purchased by the purchaser. This is completely unrelated to the original purchaser having indicated, e.g., his/her favorite drink and/or venue preference as part of his/her “instant reciprocity” settings (see the Applicant’s specification at p. 25, lines 21-22), and using these stored settings to pre-populate the fields of the instruction from the recipient, as discussed

above with reference to claim 140. Fredlund does not teach, disclose, or even suggest a pre-supplied portion of a purchase instruction at all, let alone pre-supplying any of items (i)-(vi) of claim 141 as a portion of a purchase instruction. This provides additional reasons for the assertion that claim 141 is allowable over Fredlund. For similar reasons, claims 187 and 219 are also allowable over Fredlund.

Claims 144, 190, and 220

Claim 144 recites, *inter alia*, that “the instruction specifies a plurality of specified products, each at a different set of one or more venues associated with the same recipient.¹” As discussed with the Examiner during the 8/20/07 interview, nowhere does Fredlund teach, disclose, or even suggest a single purchase instruction that specifies a plurality of products to purchase, wherein each of the products is at a **DIFFERENT** set of one or more venues associated with the **SAME** recipient. An example of this is described in the Applicant’s specification at p. 28, line 18, to p. 29, line 2, in which a purchaser buys several different drinks for the recipient at several different venues for a “barhopping” itinerary. Since Fredlund does not disclose a single instruction that specifies a plurality of specified products, each at a different set of one or more venues associated with the same recipient, claim 144 is therefore novel over Fredlund. For similar reasons, claims 190 and 220 are also novel over Fredlund.

Claims 145, 191, and 221

Claim 145 recites, *inter alia*, that “the instruction specifies a specific product for each of a plurality of different recipients associated with the set of one or more venues.” As discussed with the Examiner during the 8/20/07 interview, nowhere does Fredlund teach, disclose, or even suggest a single purchase instruction that specifies a plurality of different recipients. An example of this is described in the Applicant’s specification at p. 29, lines 3-9, in which a purchaser buys drinks for a group of recipients in a single “group purchase transaction.” Since Fredlund fails to teach, disclose, or suggest a single instruction that specifies a specific product for each of a plurality of different recipients associated with the set of one or more venues, claim 145 is therefore novel over Fredlund. For similar reasons, claims 191 and 221 are also novel over Fredlund.

Claims 146, 192, and 222

Claim 146 recites, *inter alia*, the steps of:

- (e) receiving, from a remote communications device used by the purchaser, a message indicating selection of a link (i) on a web or browser page or (ii) in an electronic or text message; and
- (f) initiating step (c) based on receipt of the message.

As discussed with the Examiner during the 8/20/07 interview, nowhere do Fredlund or Webb teach, disclose, or even suggest that step (c), i.e., receipt of the purchase instruction itself, is initiated based on the receipt of a message indicating that the purchaser has selected a link (e.g., a hypertext link) on a web page or in a text message. In Webb, clicking on the link takes the purchaser only to search results pages, home pages, or merchant pages that require the purchaser to at least navigate to the item and/or initiate a purchase instruction by filling out information, in order to purchase the item. In contrast, in the present invention as claimed in claim 146, selecting (i.e., by clicking on) the link actually initiates an instance of a purchase instruction, as described in the Applicant’s specification, e.g., at p. 27, lines 14-16. Since nowhere do Fredlund or Webb

teach, disclose, or even suggest initiating the receipt of a purchase instruction as claimed in step (c) based on receipt of a message indicating that the purchaser has selected a link (e.g., a hypertext link) on a web page or in a text message, no combination of Fredlund and Webb could possibly render claim 146 obvious. For similar reasons, claims 192 and 222 are also non-obvious over Fredlund and Webb.

Claims 152, 198, and 226

Claim 152, as amended, recites, *inter alia*, the step of “using a historical list of one or more venues physically visited by the recipient to generate the list of possible venues.” As the Applicant’s attorney discussed with the Examiner during the 8/20/07 interview, Fredlund and Kraemer both fail to disclose using a list of venues physically visited by the recipient to generate a list of venues. Therefore, no combination of Fredlund and Kraemer could possibly render claim 152 obvious. For similar reasons, claims 198 and 226 are also non-obvious over Fredlund and Kraemer.

Claims 153-156, 199-202, and 227-229

Claim 153 recites, *inter alia*, that “the recipient specifies the list of one or more possible venues” and the step of “receiving the list of one or more possible venues from the recipient.” The Examiner cites to paragraph [0034] of Fredlund in rejecting claim 153 as obvious over Fredlund on page 9 of the Action, asserting that the “[m]ethod step recited in Fredlund would remain the same regardless who is the purchaser and who is the recipient, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said purchaser is a recipient, because it would advantageously allow to increase revenue.” First, this argument also makes no sense, because the purchaser is not a recipient in claim 153! Second, as the Applicant’s attorney discussed with the Examiner during the 8/20/07 interview, paragraph [0034] of Fredlund simply does not teach, disclose, or even suggest what is being claimed. Claim 153 recites that it is the recipient who supplies the list of venues from which the purchaser makes a selection. Paragraph [0034] of Fredlund reads as follows:

[0034] The back view of postcard 40 shows a message area 48 for the inclusion of a message for recipient R. Message area 48 can, for example, provide notification of user's U creation of an image bearing product. This may be an automatic message or a message generated by user U. Postcard 40 also includes an identifier area 50 for the inclusion of identifier ID. Postcard 40 preferably includes a store location area 52, providing, for example, a listing of the names/addresses of stores having kiosks. If recipient R's image bearing product is a photo product such as a tee shirt or mug, store location area 52 could specify the specific store/location for recipient R to pick up the product. Optionally, store location area 52 may be used as an advertising area, for example for advertising specific stores, store events, store openings, store coupons, and special store promotions.

It can plainly be seen that paragraph [0034] does not disclose that a recipient supplies a list of venues from which the purchaser makes a selection. Therefore, the Examiner has not set forth a *prima facie* case for obviousness of claim 153, and claim 153 is non-obvious over Fredlund. For similar reasons, claims 199 and 227 are also non-obvious over Fredlund. Since claims 154-156, 200-202, 228, and 229 depend variously from claims 153, 199, and 227, it is further submitted that those claims are also allowable over Fredlund.

Moreover, claim 154 recites further subject matter not taught, disclosed, or even suggested in Fredlund, namely, that the specification of the list of one or more possible venues by the recipient occurs at a substantially different time from the receipt of the instruction in step (a). In rejecting claim 154 as obvious over Fredlund on page 10 of the Action, the Examiner argues that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said “specification” [of the list of venues] and “receiving” [of the instruction in step (a)] steps are conducted substantially simultaneously or at the same time, because it would advantageously allow the purchaser/recipient to take time to make a decision in selecting the most appropriate venue. This argument does not make sense. This is because claim 154 recites that the “specification” and “receiving” steps occur at substantially different times, not substantially simultaneously or at the same time, as argued by the Examiner. Thus, the Examiner has not set forth a *prima facie* case for obviousness of claim 154, and claim 154 is non-obvious over Fredlund. For similar reasons, presently-pending claim 200 and 228 are also non-obvious over Fredlund.

Furthermore, claim 155 recites that “the recipient specifies a single venue as the list of one or more possible venues, the single venue being a venue at which the recipient is currently located.” In rejecting claim 155 as obvious over Fredlund on page 10 of the Action, the Examiner cites to paragraphs [0029], [0030], and [0034] of Fredlund, asserting that the “[m]ethod step recited in Fredlund would remain the same regardless who is the purchaser and who is the recipient; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said purchaser is a recipient, because it would advantageously allow to increase revenue.” This argument also makes no sense, because the purchaser is not a recipient in claim 155! To the contrary, claim 155 recites that the recipient specifies the venue at which he/she is currently located as a venue to present to the purchaser when making the purchase. Neither paragraphs [0029], [0030], and [0034] of Fredlund, nor any other portion of Fredlund discloses, teaches, or even suggests a recipient specifying a single venue as the list of one or more possible venues, wherein the single venue is a venue at which the recipient is currently located. Again, the Examiner has not set forth a *prima facie* case for obviousness of claim 155, and claim 155 is non-obvious over Fredlund. For similar reasons, claims 201 and 229 are also non-obvious over Fredlund.

Claims 164, 210, and 231

Claim 164 recites, *inter alia*, that “the list of the at least one product is provided by the recipient,” and further recites a step of “receiving the list of the at least one product from the recipient in advance of receipt of the instruction from the purchaser.” In this scenario, the recipient has already selected products that the recipient would like to receive, and a list of such products is provided to the purchaser from which to make a selection. As the Applicant’s attorney discussed with the Examiner during the 8/20/07 interview, Fredlund does not disclose a step of receiving a list of one or more available products from the recipient prior to receiving the instruction from the purchaser. Rather, what Fredlund describes in the paragraph ([0032]) cited by the Examiner instead describes a recipient selecting products other than what the purchaser had originally indicated after the purchaser has already made the purchase! (See paragraph [0029] of Fredlund, which states that in the example of paragraph [0032], “a person, located in California, wishes to send his cousin, located in New York, an 8x10 photograph of their grandmother on her 80th birthday”). Therefore, the Examiner has not set forth a *prima facie* case for anticipation of claim 164, and claim 164 is novel over Fredlund. For similar reasons, claims 210 and 231 are also novel over Fredlund.

Claims 166, 212, and 232

Claim 166 recites, *inter alia*, “(e) **storing an account balance** for the purchaser; and (f) debiting or crediting the account balance based on the instruction.” In rejecting claim 166 as anticipated by Fredlund on page 7 of the Action, the Examiner cites to paragraph [0049] of Fredlund, which reads as follows:

[0049] System 5 may include means for paying for the image bearing product. For example, payment may be provided by the user by entering a credit card number to a kiosk using either a keypad or other known credit card reading device. Thus, system 5 would charge the user's credit card account. The user could limit the dollar amount that may be charged. In this manner, the recipient may choose from a number of output options that have differing prices. Optionally, payment may be provided to a store clerk (or other point of sale capability) by cash, check, or credit card, and the store clerk could acknowledge the prepayment for the image bearing product via the kiosk.

It can plainly be seen that paragraph [0049] does not disclose a step of **storing an account balance for the purchaser**. Rather, paragraph [0049] describes using traditional payment methods, such as cash, check, or credit card, to make payment. Nor does any other portion of Fredlund disclose a step of **storing a purchaser's account balance**. Therefore, claim 166 is novel over Fredlund. For similar reasons, claims 212 and 232 are also novel over Fredlund.

Claims 169, 215, and 234

Claim 169 recites, *inter alia*, the step of “prior to receipt of the instruction from the purchaser, receiving from a recipient and providing **to a plurality of purchasers** a message indicating at least one desired product and/or at least one venue specified by the recipient.” An example of this is described in the Applicant's specification at p. 29, lines 10-16, wherein an end user sends out a broadcast message (e.g., to a group of friends) inviting recipients to buy him or her a particular drink at a particular venue. As discussed with the Examiner during the 8/20/07 interview, neither Fredlund nor Kraemer discloses providing **to a plurality of purchasers** a message indicating a recipient's desired product and/or venue. While, in Kraemer, **a single purchaser** can browse a registry that stores items indicated as desired by a recipient (pg. [0046]), Kraemer **does not use a message** that is sent to **a plurality of purchasers** as a way of notifying the purchasers about the desired items.

Moreover, the motivation to combine Fredlund and Kraemer provided by the Examiner, i.e., “it would advantageously allow to avoid duplicate gift purchases,” makes no sense. In the present invention, as claimed in claim 169, there is no attempt made to avoid duplicate gift purchases. Indeed, informing a plurality of purchasers of a desired gift, i.e., a drink at a venue, using a message sent to all of the purchasers, could desirably bring a recipient multiple instances of the same gift, i.e., several drinks at the venue. This is quite different from a gift registry, in which an item is removed from the registry once purchased. Therefore, Fredlund and Kramer cannot properly be combined to render 169 obvious, and even if these references were properly combinable, no combination of Fredlund and Kraemer could possibly render claim 169 obvious. For similar reasons, claims 215 and 234 are also non-obvious over Fredlund and Kraemer.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire

application is now in condition for allowance, and early and favorable action is respectfully solicited.

In the event that the Examiner believes that this Preliminary Amendment does not place the application in condition for allowance, the Applicant requests a telephonic interview between the Examiner and the Applicant's attorney Kevin Drucker to discuss this Amendment. The Applicant requests that the Examiner call Mr. Drucker (215-557-6659) to arrange a convenient time for such an interview.

Respectfully submitted,

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